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10/025,957	12/18/2001	James P. Hammons	EFUN102	2141

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EXAMINER
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THEIN, MARIA TERESA T

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 06/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/025,957

Applicant(s)

HAMMONS ET AL.

Examiner

Marissa Thein

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 December 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)                | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>12-18-01</u> .  | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Information Disclosure Statement***

The information disclosure statement (IDS) submitted on December 18, 2001 is being considered by the examiner.

### ***Drawings***

The drawings filed on April 4, 2002 are acceptable.

### ***Claim Objections***

Claim 12 is objected to because of the following informalities: because the recitation of "The method of claim 6" should be --The method of claim 8--. Appropriate correction is required.

Claim 18 is objected to because of the following informalities: because the recitation of "The method of claim 13" should be --The method of claim 14--. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 14 and 19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 14 and 19 recite, "direct submission

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information by a third party of identifying information of a system user who has an interest in the offers presented” and “direct submission by a third party system user regarding the party for whom the third party system user intends upon purchasing gifts” which are not disclosed in the specification.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**Claims 9, 14, 16 and 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Regarding claim 9, the phrases “the gift receiving recipient” and “the event” lack antecedent basis.

Regarding claim 16, the phrase “said interactive accepting of purchases, transactions and processes.....” lacks antecedent basis.

Regarding claims 14 and 19, the phrase “third party” is unclear. It is not clear whom the Applicant is identifying as the third party. Examiner will interpret the claims in the broadest reasonable interpretation.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claim 1 and 5 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,609,106 to Robertson.**

Regarding claim 1, Robertson discloses a method for providing specific product information and offers for sale to the system user, the method comprising the steps of: gathering product information regarding a variety of products offers and information (col. 2, lines 14-25; col. 10, lines 39-41); organizing the product offers and information based upon predetermined criteria (col. 9, lines 34-37; col. 10, lines 51-53); saving the organized product offers and information in a database (col. 12, lines 26-37); gathering system user profile information from the system user (col. 20, lines 10-16; Figure 16); organizing the system user profile information, according to predetermined criteria (col. 20, line 65 – col. 21, line 13); saving the organized system user profile information (col. 20, line 65 – col. 21, line 13); matching the organized product offers and information to the organized system user profile information according to a designated criteria (col. 18, lines 34-55); selecting matched product offers and information to be transmitted to the display device based upon desired criteria (Figure 33, col. 18, lines 51-60); delivering the matched product offers and information to the system user through the display devices (Figure 33); storing the matched product offers and information on the display device (col. 19, lines 5-11; col. 23, lines 57-65); displaying the delivered matched

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product offers and information on the display device (Figure 33; Figure 36); and transmitting transaction request from the system user (Figures 37).

Regarding claim 5, the product offers and information are displayed immediately (Figure 33; Figure 36).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claim 2, 4, 6-7, 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,609,106 to Robertson in view of U.S. Patent No. 5,991,771 to Falls.** Robertson substantially discloses the claimed invention, however, it does not disclose the display device being connected and not being connected to the network; product offers and information are reserved for later display when the display device is no longer attached to the network; and to store the transaction and automatically connect to said network at a later time. However, Robertson discloses storing various account informations with respects to the users (col. 12, lines 58-60).

Falls, on the other hand, teaches the display device being connected and not being connected to the network; product offers and information are reserved for later display when the display device is no longer attached to the network; and to store the transaction and automatically connect to said network at a later time (col. 3, line 66 – col. 4, line 15).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method of Robertson, to include the display device being connected and not being connected to the network; product offers and information are reserved for later display when the display device is no longer attached to the network; and to store the transaction and automatically connect to said network at a later time, as taught by Falls, in order to provide consistent file locations regardless of whether the computer is connected the network (col. 3, lines 9-11).

**Claim 3 is are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,609,106 to Robertson in view of U. S. Patent No. 6,202,051 to Woolston.** Robertson substantially discloses the claimed invention, however, it does not explicitly disclose placing bids in an electronic auction, placing items for sale in an auction, and making offers to sell to a third party. Robertson discloses ordering a product (col. 24, lines 9-11).

Woolston, on the other hand, teaches placing bids in an electronic auction (Figures 5-6), placing items for sale in an auction (Figure 3), and making offers to sell to a third party (Figure 7).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method of Robertson, to include placing bids in an electronic auction, placing items for sale in an auction, and making offers to sell to a third party, as taught by Woolston, in order to market goods so that participants can speculate on the price of the goods (Woolston, col. 1, lines 30-32) and to provide resale of goods purchased (Woolston, col. 1, lines 62-63).



**Claims 8-9 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,609,106 to Robertson in view of U.S. Patent No. 5,983,200 to Slotznick.** Robertson substantially discloses the claimed invention, however, it does not explicitly disclose the gift-giving information from the system user about the system user's gift-giving recipients and gift receiving recipient and the event for which the gift is to be selected. Robertson discloses a "Choose a Gift for Someone" link (Figure 15) and a Reminders (340) link (Figure 21). When the user chooses the "Choose a Gift for Someone" link, a Gift Recipient Selection Page is displayed to the user (col. 22, lines 59-61).

Slotznick, on the other hand, teaches disclose the gift-giving information from the system user about the system user's gift-giving recipients and gift receiving recipient and the event for which the gift is to be selected (col. 18, lines 36-58).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method of Robertson, to include the gift-giving information from the system user about the system user's gift-giving recipients and gift receiving recipient and the event for which the gift is to be selected, as taught by Slotznick, in order to provide a proper and appropriate gift (Slotznick, col. 14, lines 39-40).

Regarding claim 13, Robertson discloses the displayed offers can be accessed either from said display device or from a designated website (Figure 33; Figure 36).

**Claims 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,609,106 to Robertson and U.S. Patent No. 5,983,200 to**



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**Slotznick and in further view of U.S. Patent No. 5,991,771 to Falls.** The combination of Robertson and Slotznick substantially discloses the claimed invention, however, the combination does not disclose the system user is able to initiate a transaction when the device is not connected to the network; and to store the transaction and automatically connect to said network at a later time. The combination discloses storing various account informations with respects to the users (Robertson, col. 12, lines 58-60).

Falls, on the other hand, teaches the system user is able to initiate a transaction when the device is not connected to the network; and to store the transaction and automatically connect to said network at a later time (col. 3, line 66 – col. 4, line 15).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the combination, to include the system user is able to initiate a transaction when the device is not connected to the network; and to store the transaction and automatically connect to said network at a later time, as taught by Falls, in order to provide consistent file locations regardless of whether the computer is connected the network (col. 3, lines 9-11).

**Claim 14 –18 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,609,106 to Robertson in view of U.S. Patent No. 5,983,200 to Slotznick and in further view of U.S. Patent No. 5,991,771 to Falls.**

The Examiner notes that claim 14 is rejected as best understood in the view of the 35 U.S.C. 112 rejections.

Regarding claims 14-18, Robertson discloses a method for providing specific product information and offers for sale to the system user, the method comprising the

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steps of: gathering product information regarding a variety of products offers and information (col. 2, lines 14-25; col. 10, lines 39-41); organizing the product offers and information based upon predetermined criteria (col. 9, lines 34-37; col. 10, lines 51-53); saving the organized product offers and information in a database (col. 12, lines 26-37); gathering system user profile information from the system user (col. 20, lines 10-16; Figure 16); saving the organized system user profile information (col. 20, line 65 – col. 21, line 13); gathering direct submission information by a third party of identifying information of a system user who has an interest in the offers presented (col. 13, lines 7-22); organizing the system user profile information, and the third party interest direct submission information according to selected criteria based upon the user (col. 20, line 65 – col. 21, line 13); saving the system user profile information and the third party interest identification information (col. 20, line 65 – col. 21, line 13); organizing the system user profile information, and gift-giving information according to predetermined criteria (col. 20, line 65 – col. 21, line 13); matching the product offers and information to the system user profile information and to the gift giving information and profiles based upon selected criteria (col. 18, lines 34-55); selecting product offers and information to be transmitted to the display device based upon matched product results and selected criteria (Figure 33, col. 18, lines 51-60); delivering program matched product offers and information to the system user through the display devices (Figure 33); storing the program matched product offers and information on the display device (col. 19, lines 5-11; col. 23, lines 57-65); receiving offers and information as selected by the shopper and storing the selected offers and information (Figure 33; Figure 36); displaying on the

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display device the selected offers and information, and the matched product offers and information upon request by the system user (Figure 33; Figure 36); and providing opportunities for interactive purchasing and communication through the display devices (Figure 33; Figure 36; Figure 37).

However, Robertson does not explicitly disclose the gift-giving information and profiles regarding future gift recipients from the system user, gift recipient's interests and attributes, a specified list of gift giving events for each gift recipient; and initiating specific processes from the display. Robertson discloses a "Choose a Gift for Someone" link (Figure 15) and a Reminders (340) link (Figure 21). When the user chooses the "Choose a Gift for Someone" link, a Gift Recipient Selection Page is displayed to the user (col. 22, lines 59-61).

Slotznick, on the other hand, teaches disclose the gift-giving information and profiles regarding future gift recipients from the system user, gift recipient's interests and attributes, a specified list of gift giving events for each gift recipient; and initiating specific processes from the display (col. 12, lines 56-67; col. 15, lines 7-16; col. 16, lines 52-61; col. 18, lines 36-58).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method of Robertson, to include the gift-giving information and profiles regarding future gift recipients from the system user, gift recipient's interests and attributes, a specified list of gift giving events for each gift recipient; and initiating specific processes from the display, as taught by Slotznick, in

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order to provide a proper and appropriate gift (Slotznick, col. 14, lines 39-40) and to provide an interactive screen (Slotznick, col. 15, lines 41).

Robertson does not explicitly disclose the storing the displayed offers and information for later on-demand access; the displayed offers can be accessed from a location other than the display device; and the displayed device is not connected to the network and the device is able to store a transaction, purchase, and process for transmission until a connection between the display and the network becomes available. Robertson discloses storing various account informations with respects to the users (col. 12, lines 58-60).

Falls, on the other hand, teaches the storing the displayed offers and information for later on-demand access; the displayed offers can be accessed from a location other than the display device; and the displayed device is not connected to the network and the device is able to store a transaction, purchase, and process for transmission until a connection between the display and the network becomes available (col. 3, line 66 – col. 4, line 15).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method of Robertson, to include the storing the displayed offers and information for later on-demand access; the displayed offers can be accessed from a location other than the display device; and the displayed device is not connected to the network and the device is able to store a transaction, purchase, and process for transmission until a connection between the display and the network becomes available, as taught by Falls, in order to provide consistent file

locations regardless of whether the computer is connected the network (col. 3, lines 9-11).

**Claim 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,609,106 to Robertson in view of U.S. Patent No. 5,983,200 to Slotznick and in further view of U.S. Patent No. 5,991,771 to Falls and in further view of U. S. Patent No. 6,202,051 to Woolston.**

The Examiner notes that claim 19 is rejected as best understood in the view of the 35 U.S.C. 112 rejections.

Regarding claim 19, Robertson discloses the method comprising the steps of: gathering information regarding product offers and information from a variety of sources (col. 2, lines 14-25; col. 10, lines 39-41); organizing the information regarding product offers and information based upon a predetermined criteria (col. 9, lines 34-37; col. 10, lines 51-53); saving the organized information regarding product offers and information (col. 12, lines 26-37); gathering system user profile information from the system user by any one of a combination of methods selected from the group consisting of: direct submission from the system users through answers on a profile, monitoring customer interaction with a provided software program, direct submission by a third party system user regarding the party for whom the third party system user intends upon purchasing gifts, and direct submission by a third party of identifying information of a system user who has an interest in the offers presented (Figure 21); gathering third party identification profiles from the system user (...); organizing the system user profile

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information, the third party interest identification profiles according to selected criteria based upon the system user (col. 20, line 65 – col. 21, line 13); saving the system user profile information, the third party interest identification information (col. 20, lines 65- col. 21, lines 13); organizing the system user profile information, and the gift-giving information according to predetermined criteria (col. 20, line 65- col. 21, line 13); matching the product offers and information to the system user profile information and to the gift recipient profiles and the third party interest identification profiles according to selected criteria (col. 18, lines 34-55); organizing the matched product offers and information (col. 19, lines 5-11; col. 23, lines 57-65); delivering the matched product offers and information to said system users and said third parties via said network (Figure 33); storing the matched product offers and information (col. 19, lines 5-11; col. 23, lines 57-65); and transmitting transaction requests from the user wherein the transaction requests making offers to purchase from a seller (Figure 33; Figure 36; Figure 37).

However, Robertson does not explicitly disclose the gathering system user gift-recipient profiles and a specified list of gift giving events for each gift recipient.

Robertson discloses a “Choose a Gift for Someone” link (Figure 15) and a Reminders (340) link (Figure 21). When the user chooses the “Choose a Gift for Someone” link, a Gift Recipient Selection Page is displayed to the user (col. 22, lines 59-61).

Slotznick, on the other hand, teaches disclose the gathering system user gift-recipient profiles and a specified list of gift giving events for each gift recipient (col. 18, lines 36-58).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method of Robertson, to include the gathering system user gift-recipient profiles and a specified list of gift giving events for each gift recipient, as taught by Slotznick, in order to provide a proper and appropriate gift (Slotznick, col. 14, lines 39-40).

Robertson does not explicitly disclose displaying the matched product offers and information after disconnecting the personal computer from said network and transaction requests being stored within the display device until the display device is connected to the network, whereupon the transaction requests are transmitted to the information system computer. Robertson discloses storing various account informations with respects to the users (col. 12, lines 58-60).

Falls, on the other hand, teaches displaying the matched product offers and information after disconnecting the personal computer from said network and transaction requests being stored within the display device until the display device is connected to the network, whereupon the transaction requests are transmitted to the information system computer (col. 3, line 66 – col. 4, line 15).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method of Robertson, to include displaying the matched product offers and information after disconnecting the personal computer from said network and transaction requests being stored within the display device until the display device is connected to the network, whereupon the transaction requests are transmitted to the information system computer, as taught by Falls, in order to provide



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consistent file locations regardless of whether the computer is connected the network (col. 3, lines 9-11).

However, Robertson does not explicitly disclose placing bids in an electronic auction, placing items for sale in an auction, and making offers to sell to a third party. Robertson discloses ordering a product (col. 24, lines 9-11).

Woolston, on the other hand, teaches placing bids in an electronic auction (Figures 5-6), placing items for sale in an auction (Figure 3), and making offers to sell to a third party (Figure 7).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method of Robertson, to include placing bids in an electronic auction, placing items for sale in an auction, and making offers to sell to a third party, as taught by Woolston, in order to market goods so that participants can speculate on the price of the goods (Woolston, col. 1, lines 30-32) and to provide resale of goods purchased (Woolston, col. 1, lines 62-63).

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent No. 5,774,874 to Veeneman et al. discloses multi-merchant gift registry.

U.S. Patent No. 6,611,814 to Lee et al. discloses a system and method for using virtual wish lists for assisting shopping over computer networks.

[www.gifts.com](http://www.gifts.com) discloses a method of buying gifts to recipients.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marissa Thein whose telephone number is 571-272-6764. The examiner can normally be reached on M-F 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alex Kalinowski can be reached on 571-272-6771. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

mtot  
June 13, 2005

*Michael Cuff* 6/13/05  
**MICHAEL CUFF**  
**PRIMARY EXAMINER**